

REMARKS

The Office Action dated December 28, 2004 has been received and carefully noted. The following remarks are submitted as a full and complete response thereto. Claims 1-7, 10-12, 16, 18-24, 27-29 and 33 are again respectfully submitted for consideration.

The Office Action rejected claims 1, 3, 10, 11, 16, 18, 19, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* (U.S. Patent No. 5,313,463). The Office Action also rejected claims 2, 4, 19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Wrede et al.* (U.S. Patent No. 5,937,040). Claims 5 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of the *European Telecommunication Standards Institute Reference* (February 1996). Claims 6 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of the *European Telecommunication Standards Institute Reference* (October 1991). Claims 7 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Newton's Telecom Dictionary* (March 1998). Claims 12 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Masuda* (U.S. Patent No. 4,709,387). The above rejections are respectfully traversed based on the remarks that follow.

The Office Action took the position that *Gore et al.* taught all of the elements of claims 1, 3, 10, 11, 16, 18, 19, 27 and 28, with the exceptions of specifying that information requested by the called subscriber to the exchange about the calling

subscriber and sent from the server into the exchange is that of telephone book information and that the first and third interfaces can be implemented as ISDN interfaces. The Office Action took the position that those exceptions would have been obvious in view of *Gore et al.* and general knowledge of the prior art. The Office Action also acknowledges that with respect to the rejection of claims 2, 4 19 and 21, *Gore et al.* fails to teach the transmission of the calling subscriber telephone book information in the form of a text message through USS signaling and cites *Wrede et al.* as curing this deficiency. With respect to the rejection of claims 5 and 22, the Office Action also acknowledges that *Gore et al.* fails to teach the transmission of the calling subscriber telephone book information using USBS signaling and cites *European Telecommunication Standards Institute Reference (February 1996)* as curing this deficiency. With respect to the rejection of claims 6 and 23, the Office Action also acknowledges that *Gore et al.* fails to teach the step of having the server distinguish the telephone book information service provided via MSN and a number of terminal-specific identification numbers and cites *European Telecommunication Standards Institute Reference (October 1991)* as curing this deficiency. With respect to the rejections of claims 7 and 24, the Office Action also acknowledges that *Gore et al.* fails to teach the distinguishing the telephone book information service to be provided via subaddressing and cites *Newton's Telecom Dictionary (March 1998)* as curing this deficiency. With respect to the rejection of claims 12 and 29, the Office Action acknowledges that *Gore et al.* fails to teach the

storage of the calling subscriber telephone book information in the subscriber telecommunication terminal and cites *Masuda* as curing this deficiency.

The present invention is directed, according to claim 1, to a method for providing telephone book information in a digital multiple-service network. The network includes an exchange, a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first ISDN interface, and a called subscriber telecommunication terminal connected to the network via a second ISDN interface. The method includes requesting calling subscriber telephone book information by sending from the called subscriber telecommunication terminal to the exchange a message requesting the calling subscriber telephone book information and comprising the number of the calling subscriber, the request being initiated by the called subscriber, in response to the received message, sending a query for the calling subscriber telephone book information from the exchange to a server implementing a telephone book information service, the server being connected to the multiple-service network via a third ISDN interface, in response to the received query, sending the calling subscriber telephone book information from the server to the exchange and in response to the received calling subscriber telephone book information, sending the calling subscriber telephone book information from the exchange to the called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of information not belonging to the call. Claims 2-7, 10-12 and 16 depend from claim 1.

The present invention is also directed, according to claim 18, to a system for

providing telephone book information in a digital multiple-service network. The network includes an exchange, a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first ISDN interface, and a called subscriber telecommunication terminal connected to the network via a second ISDN interface. The system includes requesting means for requesting calling subscriber telephone book information by sending, from the called subscriber telecommunication terminal to the exchange, a message requesting the calling subscriber telephone book information and comprising the number of a calling subscriber, the request being initiated by the called subscriber, first sending means for sending a query for the calling subscriber telephone book information from the exchange to a server implementing a telephone book information service, the server being connected to the multiple-service network via a third ISDN interface, in response to the received message, second sending means for sending the calling subscriber telephone book information from the server to the exchange, in response to the received query and third sending means for sending the calling subscriber telephone book information from the exchange to the called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of information not belonging to the call, in response to the received calling subscriber telephone book information. Claims 19-24, 27-29 and 33 depend from claim 18.

As discussed in the present specification, the present invention enables the connection of a server to a digital multiple-service network via an ISDN interface. It is

respectfully submitted that the prior art of *Gore et al.*, when viewed alone or when combined with other references, fails to disclose or suggest all of the elements of any of the presently pending claims. Therefore, the prior art fails to provide the critical and unobvious advantages discussed above.

Gore et al. is directed to process of credit checking in an ISDN environment. The credit check is implemented using a credit-checking database. Credit-check information is transmitted to the ISDN terminal using a D-channel and the results from the credit-checking database is passed back through the network to the sending business.

Applicants note that the arguments employed in the rejections applying *Gore et al.* appear to be similar to those made previously by the Office. The rejections indicate that the first and third interfaces of *Gore et al.* can be relied upon to teach or suggest elements of the claimed invention. The rejections allege that even though the first and second interfaces may not be ISDN interfaces, the implementation of such interfaces could be easily achieved in the system of *Gore et al.* Applicants respectfully disagree.

Gore et al. discloses path 21 connecting database 280 to telecommunications network 200. *Gore et al.* further discloses that path 21 uses Signaling System number 7 (SS7) and Transaction Capability Application Part (TCAP). *Gore et al.* also discloses that the database 280 and ESS 220 of telecommunications network 200 also use TCAP messages (See, *Gore et al.* at column 4, lines 43-60, at column 5, lines 23-35, and Fig. 2).

It is known in the art that SS7/TCAP cannot be used over BRI or PRI interfaces, that is, over ISDN interfaces. Rather, a trunk facility is required for SS7/TCAP. It

follows from this that the implementation of an ISDN interface between database 280 and telecommunications network 200 is not easily achieved on the system of *Gore et al.* Such an implementation would require replacing SS7 and TCAP used by *Gore et al.* with something compatible with ISDN interfaces. In other words, database 280 and ESS 220 of telecommunications network 200 would have to be replaced altogether or at least modified extensively to allow them to function with ISDN interfaces. Applicants respectfully assert that such replacements or modifications would not have been obvious to a person of ordinary skill in the art. This is particularly true when it is considered that *Gore et al.* fails to teach or suggest any alternatives to the above use of SS7 and TCAP for communication between data 280 and ESS 220 of telecommunications network 200.

In addition, if the change proposed in the rejection were made, the function of the system of *Gore et al.* would be inextricably altered. In other words, if the reference were altered, as suggested, to meet the limitations of the claims, it could not function as intended. If the proposed modification would render the modified prior art reference to be unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As such, Applicants respectfully assert that such modifications would not and could not have been obvious in view of the teachings of *Gore et al.*

Thus, at least the above identified portions of claims 1 and 18 are neither taught nor suggested by *Gore et al.* and Applicants respectfully assert that the rejection of claims 1 and 18 are improper and should be withdrawn.

The above-discussed deficiencies are also not cured by the addition of *Wrede et al.*, *European Telecommunication Standards Institute Reference (February 1996)*, *European Telecommunication Standards Institute Reference (October 1991)*, *Newton's Telecom Dictionary (March 1998)* and *Masuda*, in the other rejections. *Wrede et al.* is directed to a method of simultaneously transmitting speech and text. *European Telecommunication Standards Institute Reference (February 1996)* is directed to a standard for telecommunications and is alleged to provide that USBS can be used to provide unrestricted transfer. *European Telecommunication Standards Institute Reference (October 1991)* is directed to a standard for telecommunication and is alleged to provide that MSN can be used to identify terminals. *Newton's Telecom Dictionary (March 1998)* is a dictionary and is alleged to disclose that subaddressing of a name for an ISDN service can occur. *Masuda* directed to a multifunctional telephone that is capable of storing telephone numbers or telephone book information. Even if these references were accepted to disclose what the Office has alleged, which Applicants do not admit, they do not teach or suggest the elements not taught by *Gore et al.*, as discussed above. Similarly, claims 2-7, 10-12, 16, 19-24, 27-29 and 33, which depend from claims 1 and 18, should be allowed for at least their dependence on those independent claims.

To conclude, Applicants respectfully request the allowance of claims 1-7, 10-12, 16, 18-24, 27-29 and 33, and request that the application be allowed to pass to issue. If for any reason the Examiner determines that the application is not now in condition for

allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

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In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



Kevin F. Turner
Registration No. 43,437

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

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